APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/073,019	05/04/98	KIKINIS	D P1560

	EXAMINER

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DINH, K

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

	Application No.	Applicant(s)	
Office Action Summary	09/073,019	Kikinis	
	Examiner	Art Unit	
	Dinh Khanh	2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *THREE* MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will
  be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this
  communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Mar 19, 2001* .

2a) ☒ This action is **FINAL.** 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-37* is/are pending in the application.

     4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-37* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

     a) ☐ All b) ☐ Some* c) ☐ None of:

         1. ☐ Certified copies of the priority documents have been received.

         2. ☐ Certified copies of the priority documents have been received in Application No. _____ .

         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

     *See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other:

DETAILED ACTION

1.   This is in response to the Amendment D filed on 3/19/2001. Claims 1-37 are presented

for examination.

Double Patenting Rejection

2.   Claims 27-37 are presented for examination.

3.   The nonstatutory double patenting rejection is based on a judicially created doctrine

grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

improper timewise extension of the "right to exclude" granted by a patent and to prevent possible

harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA

1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

        A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to

overcome an actual or provisional rejection based on a nonstatutory double patenting ground

provided the conflicting application or patent is shown to be commonly owned with this

application. See 37 CFR 1.130(b).

        Effective January 1, 1994, a registered attorney or agent of record may sign a terminal

disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37

CFR 3.73(b).

4.   Claims 27-37 are rejected under the judicially created doctrine of double patenting over claims of U.S. Pat. No. 6,076,109.

Regarding claim 27, claim 14 of U.S. Pat. No.6,076,109 recite all limitations in claim 27 [see Col. 17 lines 4-20]. The claimed invention in the instant application is fully disclosed in the patent and it is *broader* than the claimed invention in the patent. No new invention, or new improvement is being claimed in the instant application. Applicants are now attempting *to claim broadly that which had been previously described in more detail in the claims of the patent* (*In re Van Ornum*, 214 USPQ 761 CCPA 1982).

Claim 1 in the instant application simply *omits the step* of "saves a copy of the transposed data for future communication with the same client or a client having the same or similar characteristics".

Furthermore, there is no apparent reason why applicants was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent.

Regarding claim 28, claim 15 of the above patent recite all limitations in claim 22 [see Col. 17 lines 21-22].

Regarding claim 29, claim 14 of the above patent recites all limitations in claim 29 [see Col. 17 lines 4-20].

Regarding claim 30, claim 16 of the above patent recites all limitations in claim 30 [see Col. 17 lines 23-25].

Regarding claim 31, claim 17 of the above patent recites all limitations in claim 31 [see Col. 17 lines 26-27].

Regarding claim 32, claim 23 of the above patent recites all limitations in claim 32 [see Col. 18 lines 15-19].

Regarding claim 33, claim 24 of the above patent recites all limitations in claim 33 [see Col. 18 lines 21-35].

The claimed invention in the instant application is fully disclosed in the patent and it is *broader* than the claimed invention in the patent. No new invention, or new improvement is being claimed in the instant application. Applicants are now attempting *to claim broadly that which had been previously described in more detail in the claims of the patent* (*In re Van Ornum*, 214 USPQ 761 CCPA 1982).

Claim 33 in the instant application simply *omits the step* of "saves a copy of the transposed data for future communication with the same client or a client having the same or similar characteristics".

Furthermore, there is no apparent reason why applicants was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent.

Regarding claim 34, claim 25 of the above patent recites all limitations in claim 34 [see Col. 18 lines 36-37].

Regarding claim 35, claim 26 of the above patent recites all limitations in claim 35 [see Col.18 lines 38-40].

Regarding claim 36, claim 24 of the above patent recites all limitations in claim 15 [see Col. 18 lines 21-35].

Regarding claim 37, claim 27 of the above patent recites all limitations in claim 37 [see col.18 lines 41-43].

Claim Rejections - 35 USC § 103

5.   Claims 1-9, 11, 13, 15 and 18-20 are ejected under 35 U.S.C. 103(a) as being

unpatentable over Meske et al U.S. pat. No.5,530,852 and in view of Rogers et al. US pat.

No.5,701,451.

As to claim 1, Meske discloses the steps of:

accessing a WEB page requested by the customer (user), translating (i.e., converting) the

WEB data according to the template and transmitting the translated data to the client device (see

col.5 line 58-col.6 line 36), storing the parameters as a template (HTML file, 420 of fig.4) at the

Web server (150 fig.2).

Meske does not specifically disclose creating a listing of parameters derived from one or more of

hardware or software characteristics of the client device, characteristics of a WEB page, and

preferences of a customer using the clients' device. However, Rogers discloses creating a listing

of parameters (i.e., Web server processing clients' data according to clients' parameters,

performing calculations and formatting and other services prior to the web browser or to other

locations, see abstract, fig.1, col.4 lines 40-60, col.5 lines 10-64, col.6 line 57 to col.7 line 41,

col.9 line 56 to col.10 line 11) derived from one or more of hardware or software characteristics

of the clients' device, characteristics of a WEB page, and preferences of a customer using the

clients' device (data according to the database servers 18, see col.9 line 56 to col.10 line 36).

It would have been obvious to one of ordinary skill in the art at the time the invention was made

to utilize Roger's teachings into Meske's computer's system to allow users to request

information because it would have allowed a user of a client to access and assemble information

in multiple platforms at different physical locations more quickly.

As to claim 2, Meske further teaches the parameters include details of a display used by the

clients' device (see fig.8 and col.10 lines 41-64).

Claims 3-5 are rejected as the same reasons set forth in claims 1 and 2.

Claim 6 is rejected as the same reasons set forth in claim 1 and 2. As to the added limitation,

Meske further teaches using tools for altering the characteristics (see col.9 lines 24-48 and col.10

lines 18-40).

As to claim 7, Meske further discloses the editor executing on the client device (see col.3 line

55-col.4 line 12).

As to claim 8, Meske further discloses the editor (user) executes on a WEB server as a part of a

WEB page, and is adapted for manipulation by a client accessing the WEB page (see fig.8, col.4

lines 13-51 and col.10 lines 41-64).

Claim 9 is rejected as the same reasons set forth in claim 1. Neither Meske nor Rogers discloses the use of Mark-Script. However, using Mark-Script in the network computer is well known in the Art. It would have been obvious to one of the ordinary skill in the art at the time the invention was made to utilize a well known feature in the computer system of Meske to provide platform and application independent documents in the Web because it would have enabled users to define the structure and the tags of individual documents more quickly.

Claim 11 is rejected as the same reasons set forth in claim 9. As to the added limitation, Meske further teaches the step of accessing the WEB server by the client device and initiating execution of the Script (i.e., HTML files to SGML file).

Claim 13 is rejected for the same reasons set forth in claims 1 and 11.

As to claim 15, Meske further discloses a step for reducing content of pre-fetched WEB pages before transmission to the clients' device, by consulting parameters based on characteristics of the clients' device (see col.9 lines 24-48).

As to claim 18, Meske discloses a system for Internet browsing, comprising:

a host computer connected to one or more peripheral devices and to the Internet and a WEB

server adapted for browsing the Internet for the host (see 150 of fig.2 and fig.5 and col.6 lines

15-51).

the WEB server fetches WEB pages for the host computer and reduces data content before

transmission to the host based on characteristics of one of the peripheral devices connected to the

host (see col.6 line 38-col.7 line 18 and col.9 lines 24-48).

As to claim 19, Meske further teaches the WEB server following a script furnished by the host

computer for pre-fetching WEB pages and storing them at the WEB server for transmission to

the host computer on demand (see col.1 lines 35-57, col.6 line 38-col.7 line 18 and col.9 lines

24-48).

Claim 20 is rejected as the same reasons set forth in claims 1 and 19. As to the added limitation,

Meske further teaches the step of:

a source-side template adapted for converting data requested by the WEB server to an

Hyper Text Markup Protocol (HTML) before transmission to the WEB server (see col.5 line 58-

col.6 line 37).

6.   Claims 10, 12, 14, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Meske and Rogers as applied to claim 1 above, and further in view of Judson U.S. pat.

No.5,572,643.

As to claim 10, Meske and Rogers' teachings still applied as in claims 1 and 9 above. Neither

Meske nor Rogers teaches refreshing the current Web page. However, refreshing Web page all

pre-fetched and stored WEB pages according to the list of WEB pages is generally well known in

the art as disclosed by Judson (see abstract, col.2 lines 29-53 and col.5 line 50-col.6 line 12).

It would have been obvious to one of ordinary skill in the art at the time the invention was made

to utilize Judson's teachings in Meske's network system because it would have enabled the

system to update the content Web page into the current state.

Claims 12 and 14 are rejected under the same reasons set forth in claim 10.

As to claims 16 and 17, Judson further discloses a step for passing through to a client a request

initiated by a pre-fetched page not yet transmitted to the client, either during or after pre-fetch

(see abstract and col.3 line 46-col.4 line 24) and the request is for one of a security or

identification input (see col.2 lines 6-28 and col.6 line 62-col.7 line 17). It would have been

obvious to one of ordinary skill in the art at the time the invention was made to utilize Judson's

teachings in Meske's network system because it would have enabled the system to update the content Web page into the current state.

7.   Claims 21-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mekse US pat. No.5,530,852 and Rogers as in claim 1 above and further in view of Gleeson et al US pat. No.5,627,829.

Claim 21 is rejected for the same reasons set forth in claim 1 with the combination of Meske and Rogers. Neither Meske nor Rogers discloses a first set of files is transposed into a first set of files fewer in number than the first set of files. However, Gleeson discloses a first set of files is transposed into a first set of files fewer in number than the first set of files (i.e., compressing and decompressing data) by reducing the size of data packet (see abstract, figs.12A , 12B and col.5 line 63 to col.6 line 56). It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify Meske with Gleeson's teaching because it would have reduced the number and size of data packets transferred over the wireless network.

As to claims 22 and 23, Gleeson discloses that the second set contains characteristics of the client (see col.6 lines 40-65 and col.col.8 lines 1-44), a single file (see fig.12A and col.15 line 45 to col.16 line 23). Gleeson also discloses saving a copy of transposed data for future communications (see col.16 lines 24-61 and col.col.17 lines 16-48). It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify Meske with

Gleeson's teachings because it would have reduced the number and size of data packets

transferred over the wireless network.

As to claim 25, Meske further discloses the server transposes HTML files (see col.4 lines 12-51).

Claim 26 is rejected for the same reasons set forth in claim 1.

Claims 27-31 are rejected for the same reasons set forth in claims 21-26 respectively.

Claims 33-37 are rejected for the same reasons set forth in claims 21-24 and 26 respectively.

Response to Arguments

8.   Applicant's arguments filed on 3/19/2001 have been fully considered but they are found

not persuasive.

*Applicant asserts that Rogers fails to disclose a listing of parameters for downloading

data derived from one or more software and hardware characteristics.

Examiner respectfully disagrees. Rogers discloses a listing of parameters for

downloading data derived from one or more software and hardware characteristics (i.e., using

web server processing clients's data according to clients' parameters to perform calculations

and to format other services before reporting to the web browser or to other locations in a

selected format, generating a Data Interpretation System to specify Web client's parameters, see

abstract, fig.1, col.4 lines 10-40, col.5 lines 10-64 and col.6 lines 57 to col.7 line 49 and col.9

line 56 to col.10 line 11).

*Applicant asserts that Mark-Script is not well known in the network environment.

Examiner respectfully disagrees. Rowe et al (US pat. No.5,737,599) discloses a script

(i.e., program) for preparing a list of optimzed pages to be downloaded from World Wide Web

sites by client, the first page will be downloaded and so on (see Rowe's abstract, figs.2b, 3a, 3b,

col.3 line 46 to col.4 line 46, col.25 line 10 to col.26 line 57 and col.35 line 18 to col.36 line 62).

*Applicant asserts that Meske does not disclose acquiring hardware and software

charactersitics from a client's device.

Examiner does not cite Meske for teaching the limitation. In fact, Rogers discloses

acquiring hardware and software charactersitics from a client's device as rejected above.

*Applicant asserts that Meske does not disclose transposing HTML.

Meske discloses transposing HTML (see col.4 lines 12-51).

Conclusion

9.   Claims 1-37 are **rejected.**

10.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

11.   Any inquiry concerning this communication or earlier communications from the examiner

should be directed to Khanh Dinh whose telephone number is (703) 308-8528. The examiner

can normally be reached on Monday through Friday from 8:00 A.m. to 5:00 P.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Ayaz R. Sheikh, can be reached on (703) 305-9648. The fax phone number for this

group is (703) 305-7201.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the Group receptionist whose telephone number is (703) 305 -9600.

Khanh Dinh
Patent Examiner
Art Unit 2155
6/15/2001

DAVID WILEY
PRIMARY EXAMINER